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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,526	02/13/2002	Ken Shoji	36427-176973	4063

7590 02/10/2003

Venable  
Post Office Box 34385  
Washington, DC 20043-9998

EXAMINER

TRAN, SUSAN T

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/049,526	Applicant(s) SHOJI ET AL.	
	Examiner Susan Tran	Art Unit 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other:  |

### **DETAILED ACTION**

Receipt is acknowledged of applicant's Information Disclosure Statement filed 13/02/02 and 06/05/02, Preliminary Amendment filed 02/13/02.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Warren et al. EP 0 183 436.

Warren teaches a method for reducing physiological and/or stress in human comprising a perfume composition including valerian oil as an active agent suitable for inhalation (see abstract, pages 1-2, 10, and 12).

Claims 1, 2, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Shoji et al. JP 10-204473.

Shoji teaches cosmetic products comprising aroma oil of valerian (see abstract). The valerian root oil is subjected to alkali treatment to remove fatty acid (id).

Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanida et al. JP 01-254628.

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Tanida teaches an inhaling composition comprising valerian oil that is free from malodor useful for relieving from a physiological and psychological state (stress), (see abstract).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over France et al. US 6,495,172.

France teaches a stress reducing composition comprises one or more of a volatile natural essential oil in an amount of from about 0.05% to about 5%, including valerian oil (column 4, lines 23-47; and column 5, lines 14-29). The composition can be in a steam liquid spray container to release into the air and cause inhalation of the vapors by the human (column 7, lines 4-21).

France does not teach valerian oil in a perfume composition. Nonetheless, the stress reducing composition of France is to be released into the air and subject to inhalation by the human. Therefore, it is the examiner's position that it would have been *prima facie* obvious for one of ordinary skill in the art to optimize France's stress reducing composition to obtain the claimed invention, because France teaches the use

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of valerian oil for the same purpose, e.g., inhaling valerian fragrance useful for reducing stress in human.

Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanida et al., in view of Shoji et al.

Tanida teaches an inhaling composition comprising valerian oil that is free from malodor useful for relieving from a physiological and psychological state (stress), (see abstract).

Tanida is silent as to the teaching of valerian oil that is free from fatty acid as claimed in claims 2 and 8.

Shoji teaches cosmetic products comprising a malodor free aroma oil of valerian (see abstract). The valerian root oil is subjected to alkali treatment to remove fatty acid (id). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to modify Tanida's inhaling composition using the malodor free valerian oil in view of the teachings of Shoji with the expectation of at least similar result, because the references teach the advantageous results in the use of valerian oil that is free from malodor.

Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al., in view of Tanida et al., and Shoji et al.

Warren is relied upon for the reason stated above. Warren is silent as to the teaching of valerian oil that is free from fatty acid as claimed in claims 2 and 8.

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Tanida teaches an inhaling composition comprising valerian oil that is free from malodor useful for relieving from a physiological and psychological state (stress), (see abstract).

Tanida is silent as to the teaching of valerian oil that is free from fatty acid as claimed in claims 2 and 8.

Shoji teaches cosmetic products comprising a malodor free aroma oil of valerian (see abstract). The valerian root oil is subjected to alkali treatment to remove fatty acid (id). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to modify Warren's inhaling composition using the inhaling composition in view of the teachings of Tanida and Shoji with the expectation of at least similar result, because the references teach the advantageous results in the use of valerian oil that is free from malodor and useful for inhaling.

Claims 3, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanida et al.

Tanida is relied upon for the reasons stated above. Tanida does not teach the specific amount of valerian oil as claimed. However, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, it is the position of the examiner that it would have been

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obvious for one of ordinary skill in this art to, by routine experimentation determine a suitable amount of valerian oil to obtain a useful inhalation composition, because Tanida teaches the use of about 0.15% valerian oil in the same composition for the same purpose desired by the applicant, e.g., an inhalation composition for relieving from a physiological and psychological state (stress).

#### Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simon et al., Cavadas et al., Cauffield et al., Warren et al., Denda et al., and Smith are cited as being of interest for the teachings of valerian oil in cosmetic products.

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600